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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/159,833	09/24/1998	KENICHI UTSUMI	1990.62597	5612

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EXAMINER

JACKSON, JENISE E

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 08/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/159,833

Applicant(s)

UTSUMI ET AL.

Examiner

Jenise E Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. The invention as recited in claims 1-21 are directed to a storing apparatus for protecting an access of information recorded on a medium by a password. The apparatus includes a password preserving unit, and a password verifying. However, in regards to the “default password” the Examiner fails to see how the apparatus is being protected. According to the claimed invention, there is a password verifying unit for controlling the access protection by substituting the default input password for a user input password and comparison collating with the password for access protection when there is no password input from the user. How does the password verifying unit distinguish between an unauthorized user and an authorized user, if any user who does not input a password is allowed to have access to the information on the recorded medium?

Therefore, the Examiner asserts that the claimed invention recites data embodied on a computer medium that is protected; however, the data that is stored on the medium is a secure apparatus.

Thus, these claims are rejected as being directed to non-statutory subject matter. See MPEP 2107-2107.02

3. The Examiner asserts that because the applicant fails to provide a definition of a default password, for the purpose of applying art a default password is any password that is set by default.

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Claim Rejections - 35 USC § 112-New Matter

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant's original specification on page 4, states that the password preserving unit preserves a default input password and a password for access protection. Furthermore, it states that when there is no password input from the user, the password verifying unit substitutes the default input password for the user input password with the password for access protection. *There is no mention of a general access password.* The Examiner asserts what is a general access password? Is the general access password different from the default password? The Examiner is unclear as to what the difference is between both passwords.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 5, and 18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Rupp Corporation.

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As per claims 1-2, and 18 are rejected, because Rupp Corp. teaches a storing apparatus for protecting an access of information recorded on a medium by a password, and a preserving unit, because Rupp teaches that the password can be set(i.e. preserving unit) and used continuously. Also, Rupp discloses a password verifying unit, because the verifying unit ensures that the default password is verified against the password stored on the hard disk. Furthermore, Rupp teaches that if a user does not input a password, the default password is used instead of the user input password. Thus, when the user does not input a password, the default password is compared with the password on the hard drive; therefore, once they are compared(i.e. validated) the hard disk drive is locked. Also, Rupp discloses that when a user enters a master password, the master password is compared to the password for access protection; thus when they are compared(i.e. validated) the harddrive is unlocked.

8. As per claim 5, the Examiner takes Official Notice that the step of storing passwords on a non-volatile memory is well-known. The motivation to store data(i.e. passwords) on a non-volatile memory is that the passwords that are stored, are not lost when there is a power failure or when the power is shut down.

9. Claims 1-2, 5, and 18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hideo.

10. As per claims 1 and 18, Hideo discloses a storing apparatus that is an IC card(8) for protecting access to information on the card by a password, and a password preserving unit that stores a default password(password information previously stored) and a password for access protection(password stored on the card). Also, Hideo discloses a password verifying that is a comparing part(31), because the comparing part verifies the default password and the access

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protected password by comparing the two passwords for access to the information stored on the card. If a user forgets his/her password, as a result, the user cannot input his/her password for access, thus the password information that was previously stored is substituted for a user input password and compared to the password that is stored on the IC card. Furthermore, Hideo discloses in the detailed description, that if a user inputs his/her password a comparison is made between the inputted password and the password for access protection.

11. As per claim 2, according to Merriam-Webster's Collegiate Dictionary, the definition of comparing is to be equal or a like(see pg. 234). Hideo discloses that the default password and the password for access protection are compared(same value) to allow access to the information stored on the card. Therefore, it is obvious that both passwords have the same value, because comparing passwords that have the same value, is an efficient method that insures that only authorized users are granted access.

12. As per claim 5, the Examiner takes Official Notice that the step of storing passwords on a non-volatile memory is well-known. The motivation to store data(i.e. passwords) on a non-volatile memory is that the passwords that are stored, are not lost when there is a power failure or when power is shut down. Therefore, it is obvious to have non-volatile storage, because non-volatile storage is a more secure method of storing passwords, than volatile memory.

Response To Amendment

13. In regards to the 101, the applicant states that the claims have been amended to overcome the outstanding 101 rejection, and to better define the invention. The Examiner asserts that the 101 rejection for claims 1-21 remain rejected(see pg. 2 of previous Office action), because by merely changing a default input password to a general access password does not

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overcome the 101 rejection(see pg. 2 and 3, see 101 rej. and 112 for reasons above).

14. The applicant states Rupp does not disclose or suggest the password preserving unit or the password verifying unit. Furthermore, the applicant states that Rupp suggests ideas or concepts about a default password, without providing an enabling disclosure. The Examiner asserts that the applicant has only stated that the disclosure was not enabling, without providing further information as to how it is not enabling. Furthermore, the applicant states that Rupp, is merely a sales announcement. The Examiner asserts that any prior art found, including records, journals, sales, etc. can be used in order to reject the limitations of the claimed invention. Furthermore, the reference of Rupp is before the applicant's filing date. Therefore, this meets the criteria of prior art.

15. Second, Rupp does disclose a password verifying unit and password preserving unit. According to Webster's II Dictionary, preserve is defined as to persist in or remain constant to a purpose, idea, or task(see pg. 820). Therefore, Rupp discloses a password preserving unit, because Rupp discloses a default password that remains constant because the default password the purpose of Rupp is that the default password allows a user to set a password once and use it continually. Thus, the Examiner asserts that by setting a password, this is a password preserving unit. Although, Rupp does not explicitly disclose a password verifying unit. Rupp does teach that if a user does not input a password, the default password is used instead of the user input password. Thus, when the user does not input a password, the default password is compared with the password stored; therefore, once they are compared, the password has been validated. The Examiner takes Official Notice in the art of access control with password protection that it is well-known to have a password verifying unit, that compares a passwords, and denying access if

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the password is not the same as the one stored(i.e. preserved), the motivation is that only authorized users that have been authenticated will be granted access. A teaching of this is Lee et al. discloses that when a user intends to use a computer or a program but enters an incorrect password, the user is denied access(see col. 1, lines 18-20).

16. The applicant states that Hideo does not disclose a storage apparatus in which a general access password can be used to allow essentially free access to the storage apparatus by a first or second user. The Examiner disagrees, Hideo discloses RAM(30)(storage apparatus) that holds the password number that is compared with the IC card that contains a password, to allow the user free access. The Examiner asserts that this free access is that the user does not have to type in his/her password, because the IC card contains a password and is compared to the password in RAM(30).

Action is Final, Necessitated By Amendment

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E Jackson whose telephone number is (703) 306-0426. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes can be reached on (703) 305-9711. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-0040 for regular communications and (703) 308-6306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

August 22, 2002



GAIL HAYES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100